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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,254	06/12/2000	Stefano Turri	108910-00009	4851

7590 01/10/2006

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EXAMINER
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OH, TAYLOR V

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/592,254

Applicant(s)

TURRI ET AL.

Examiner

Taylor Victor Oh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-24 and 26-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17,32-38,40 and 41 is/are rejected.
- 7) ☒ Claim(s) 18-24,26-31 and 39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/16/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### ***Final Rejection***

#### **The Status of Claims**

Claims 17-24 and 26-41 are pending.

Claims 17, 32-38, and 40-41 have been rejected.

Claims 18-24, 26-31, and 39 have been objected.

#### **Claim Objections**

Claims 18-24, 26-31, and 39 are objected to as being dependent upon a rejected base claim.

#### **Claim Rejections-35 USC 112**

1. Applicants' argument filed 10/18/05 have been fully considered but they are not persuasive.

The rejection of Claims 17, 36, and 38 under 35 U.S.C. 112, second paragraph, has been withdrawn due to the modification made in the claims in the amendment; however, the rejection of Claim 40 under 35 U.S.C. 112, second paragraph, has been maintained due to some issue present in claim 40.

Claim 40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 40, the phrase " Q can optionally include a substituent selected from heteroatoms, N,O,S, or carbonylimino, sulphonylimino, or carbonyl groups" is recited. This expression of the term " include " is vague and confusing because this does not explain what has been excluded in Q. This term " include " leaves the claim open for the exclusion of unspecified components. Therefore, an appropriate correction is required.

### **Double Patenting Rejection**

The rejection of Claims 17, 32-38, and 40-41 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 5-10, 12-13, and 27 of U.S. Patent No. 6,579,835 has been maintained due to applicants' failure to file the Terminal Disclaimer.

### **Applicants' Argument**

2. The applicants argue the following issue:

a. U.S. Patent No. 6,579,835 was filed on June 8 ,2001 and claims priority to Italian patent application no. MI00A1268, filed on June 8 ,2000 ,whereas the present application was filed on June 12, 2000, and claims priority to Italian patent application no. MI99A001303, filed on June 11, 1999; therefore, U.S. Patent No. 6,579,835 is not prior art and the submission of the Terminal Disclaimer is unnecessary.

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The applicants' argument have been noted, but these arguments are not persuasive.

With regard to applicants' argument, regardless of being the effective filing date of application prior to the effective filing date of patent, under the judicially created doctrine of obviousness-type double patenting rejection, the real issue is whether or not the conflicting patent claims fall entirely within the scope of the examined claims in the application. In this case, the U.S. Patent No. 6,579,835 does fall entirely within the scope of the presently claimed invention as discussed in the Non-final rejection dated on 7/28/05. Therefore, applicants' argument is irrelevant to the issue of the claimed invention.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*Taylor Victor Oh*  
*1/4/06*

*CEILA CHANG*  
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**PRIMARY EXAMINER**, Acting SPZ  
**GROUP 1200** *1625*